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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,493	10/29/2001	Eric Andre DesRosiers	701826-052040	7468

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EXAMINER

MOHAMED, ABDEL A

ART UNIT

PAPER NUMBER

1653

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/055,493

Applicant(s)

DESROSIERS, ERIC ANDRE

Examiner

Abdel A. Mohamed

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26, 28, 29 and 32-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26, 28, 29 and 32-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

ACKNOWLEDGMENT TO AMENDMENT, RESPONSE AND STATUS OF THE CLAIMS

1. The amendment and remarks filed 9/13/04 are acknowledged, entered and considered. In view of Applicant's request claims 1, 3-5, 7-9, 11-18, and 24-26 have been amended and claims 27, 30, 31 and 36 have been canceled. Claims 1-26, 28, 29 and 32-35 are now pending in the application. The rejections under 35 U.S.C. 102(b) over the prior art of record and the previous rejection under 35 U.S.C. 112, second paragraph for claims 1, (partially) 3-5, 7-9, 11-18, 26, 27 and 29-31 are withdrawn in view of Applicant's amendment to the claims and remarks filed 9/13/04. However, the rejection under 35 U.S.C. 112, second paragraph for claim 1 (partially), claims 21 and 22 are maintained.

ARGUMENTS ARE NOT PERSUASIVE

2. It is noted that Applicant has amended the rejected claims under 35 U.S.C. 112, second paragraph partially as suggested by the Examiner, rendering the rejection pertaining thereto moot. Thus, the rejection for the claims which have been amended according to the Examiner's suggestion have been withdrawn, but, issues in claims 1, 21 and 22 which have not been amended and have been argued by Applicant are maintained for the same reasons discussed in the previous Office action as reiterated below:

CLAIMS REJECTION-35 U.S.C. § 112^{2nd} PARAGRAPH

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1-26, 28, 29 and 32-35 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite in the recitation "substantially similar" because it is not clear as to what is substantially similar to a fatty acid mixture. There is no definition of "substantially similar" in the specification. Also, there is no disclosure of fatty acid mixture normally present in a healthy fat pad in the instant disclosure. Only fatty acid composition of heel fat pad is disclosed in Table 1 of the specification.

Claims 21 and 22 are indefinite in the recitation "a self-gelling polymeric solution" and "a thermo-gelling solution", respectively because it is not clear if the gelling occurs at higher or lower temperature.

Applicant's arguments filed 9/13/04 have been fully considered but they are not persuasive. Applicant has argued that the phrase "substantially similar" was used not to be restricted to the exact composition as the fatty acid mixture normally present in a healthy fat pad. However, by the definition of the intrinsic viscosity of the solution, one skilled in the art could vary the relative proportion of each of the fatty acids contained in a healthy fat pad to arrive at a biocompatible solution. Further, Applicant concludes by stating that based on the analysis done by Applicant, the saturated/unsaturated fatty acids ratio in all of the analyzed samples were very similar for all three fat pads. Thus,

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the phrase "substantially similar to a fatty acid mixture normally present in a healthy fat pad" is important as a guide to enable one skilled in the art to distinguish the solution being claimed. Without such phrase, one could not use a solution that has a very high intrinsic viscosity; almost to the point that is no longer a solution is unpersuasive.

Contrary to Applicant's arguments, one of ordinary skill in the art can not determine by the phrase "substantially similar" how much is substantially similar to a fatty acid mixture normally present in a healthy fat pad because in view of the fact that the fatty acid mixture present in a healthy fat pad of individual is not the same (i.e., different individuals have different amount of fatty acid mixtures in their fat pads) with respect to viscosity value and composition value. Further, as stated above, there is no definition for the phrase "substantially similar" in the specification. Also, there is no disclosure of fatty acid mixture normally present in a healthy fat pad in the instant disclosure, and as such, one of ordinary skill in the art would not be able to determine the phrase "substantially similar" in the manner claimed. Thus, in view of the above, the definiteness of the claim is important to allow others who wish to enter the market place to ascertain the boundaries of protection that is provided by the claim. See *Ex parte Kristensen*, 10 USPQ 2d. 1701, 1703 (PTO Bd. App. & Inter. 1989). Hence, in order to obviate the above rejection, it is suggested that Applicant amend the claim to particularly point out and distinctly claim the subject matter, which Applicant regards as the invention.

With respect to claims 21 and 22, Applicant assertion that the specification clarifies that the solution may be a gel, or solid at low to room temperature, e.g., 20

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degrees Celsius and below, but may become more or less a viscous liquid at higher temperatures, e.g., above 35-40 degrees Celsius is noted. Incorporation of the temperatures limitations in claims 21 and 22 respectively would obviate the rejections of claims 21 and 22.

NEW GROUND OF REJECTION

4. The following is a new ground of rejection necessitated by Applicant's amendment:

Claims 4, 5, 17, 24-26 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4 and 5 are indefinite in the recitation "...containing one or more groups selected from....." because it is not clear if Applicant intends a Markush format. If Applicant intends to use a Markush format, then, the Office recommends the use of the phrase ".....selected from the group consisting of....." in listing species to ensure the Markush group is "closed".

Claim 17 is inconsistent with other claims the recitation "wherein the solution contains". Amendment of the claim to recite "wherein the solution comprises" is suggested (See e.g., claims 16 and 18).

Claims 24 and 25 are grammatically indefinite in the recitation ".....comprises of collagen". Amendment of the claims to recite ".....comprises collagen" would obviate this rejection.

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Claim 26 is indefinite in the recitation "components elected". It is believed to be typographical error. Amendment of the claim to recite "components selected" is suggested.

Claim 28 is indefinite in depending upon canceled claim 27. Appropriate correction is required.

ACTION IS FINAL, NECESSITATED BY AMENDMENT

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

CONCLUSION AND FUTURE CORRESPONDANCE

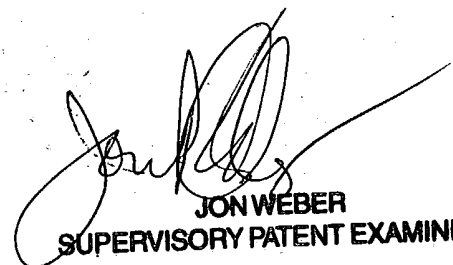
6. No claim is allowed.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdel A. Mohamed whose telephone number is (571) 272 0955. The examiner can normally be reached on First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon P. Weber can be reached on (571) 272 0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JON WEBER
SUPERVISORY PATENT EXAMINER

 Mohamed/AAM
November 22, 2004